2566-158

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
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Robert A. FERSTENBERG et al.)
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Serial No. 09/209,815)
) Examiner: James W. Myhre
Filed: December 11, 1998)
) Group Art Unit: 3622
For: COMPUTER METHOD AND)
SYSTEM FOR INTERMEDIATED) Confirmation No. 6481
EXCHANGE OF COMMODITIES)

PETITION TO THE DIRECTOR UNDER 37 CFR § 1.181(a)

Director of the United States Patent
and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

This is a petition from the objection to claims 127, 128, 139, 146 and 147 of the above-identified application, which claims were objected to under 37 CFR § 1.75(c) in the Office action dated November 12, 2004 as allegedly being of improper dependent form. The claims are presented in an Appendix to this Petition for the convenience of the Director.

HISTORY OF THE PROCEEDINGS AND SHOWING UNDER 37 CFR § 1.181(c)

Claims 116-121, 123 and 125-147 are pending in the application. The final rejection of claims 116-121, 123 and 125-147 was reversed by the Board of Patent Appeals and Interferences in a decision dated June 18, 2004.

Claims 139 and 147 were first rejected under the fourth paragraph of 35 U.S.C. § 112 and under 35 U.S.C. § 101 in the Office action dated May 3, 2002. The premise of those grounds of rejection was that the claims were improper because they "discuss structure (apparatus) in a method claim which is improper because they cannot further limit the method as previously claimed;" and because they "embrace[] or overlap[] two different statutory classes of invention set for (*sic, forth*) in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only."

These grounds of rejection were traversed, and reconsideration thereof requested, in the response filed June 11, 2002. Claim 128 was then added to the group of claims and the rejection under 35 U.S.C. § 112 fourth paragraph and under 35 U.S.C. § 101 was repeated in the final Office action dated October 8, 2002.

These grounds of rejection were appealed to the Board of Patent Appeals and Interferences, and arguments in favor of reversal of such grounds were presented in the Appeal Brief filed January 10, 2003.

The Examiner's Answer dated March 27, 2003 then retracted these grounds of rejection, stating "[i]t is proper to object to this type of claim as being an improper

dependent claim based on MPEP paragraph 608.01(n), Section III as not passing the 'infringement test'. As an objection, this issue becomes subject to petition, not appeal."

By retracting the rejections under 35 U.S.C. § 101 and § 112, fourth paragraph, and recasting the same issues under the guise of an objection under 37 CFR § 1.75(c), the Examiner has unnecessarily prolonged resolution of those same issues, which could have been resolved by the Board in the appeal.[1] Moreover, because the same questions have been raised under the Rule 75 objection as were at issue in the § 112 and § 101 rejections, Applicants' request for reconsideration filed June 11, 2002, and Applicants' arguments on appeal as presented in the Brief filed January 11, 2003, should be considered as meeting the requirement for requesting reconsideration under 37 CFR § 1.181(c), and this Petition therefore should be now entertained and decided by the Director to finally resolve these issues.

ISSUE

This petition presents the following issue for decision by the Director:

1) Whether claims 127, 128, 139, 146 and 147 are of improper dependent form under 37 CFR § 1.75(c), and are properly objected to on that basis.

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1 It is instructive to note that although it had the authority to do so, the Board did not reinstitute the §101 and §112 rejections under 37 CFR § 1.196(b).

GROUNDS FOR PETITION

The Objection to Claims 127, 128, 139, 146 and 147 Under 37 CFR § 1.75(c) Is Improper

The Examiner alleges that dependent claims 127, 128, 139, 146 and 147 are improper because "[t]he above claims are written in dependent format (referencing a prior method claim). However, the claims do not further limit the steps involved in the parent method claim." The Examiner's position is erroneous, and the objection should be vacated.

37 CFR § 1.75(c) provides that "one or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application." Claims 127, 128, 139, 146 and 147 are in full compliance with 37 CFR § 1.75(c), in that those claims incorporate by reference all the limitations of the claims to which they refer, and specify further limitations of the subject matter being claimed by requiring that the method steps be stored as computer-executable instructions in a computer-readable medium.

The present issue raised by the Examiner is not one of first impression, but to the contrary has been a source of confusion for many patent examiners over the years. Like the fourth paragraph of 35 U.S.C. § 112. Rule 75(c) does not require that a claim dependent from an apparatus claim contain a structural limitation, or that a claim dependent from a method claim contain a process limitation, but rather merely that the claim specify a further limitation of the subject matter claimed. In this regard, a dependent and independent claim need not necessarily fall within the same statutory class of subject matter. See MPEP § 608.01(n) at 600-77 (8th Edition, 2001). The purpose of Rule 75(c), as the purpose of the

fourth paragraph of § 112, is to prohibit a dependent claim from eliminating or modifying limitations set forth in a previous claim, not to dictate the nature of the further limitations to the subject matter claimed. See Ex parte Porter, 25 USPQ2d 1144, 1147 (BPAI 1992) (a claim is in compliance with the fourth paragraph of 35 U.S.C. § 112 if it incorporates by reference all of the subject matter of another claim, and is not broader than such claim in any respect).

As stated in MPEP § 608.01(n) III, the test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends, or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

Further, according to MPEP § 608.01(n):

> A dependent claim does not lack compliance with 35 U.S.C. § 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under 35 U.S.C. § 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.

In the outstanding action, the Examiner suggests that the objection can be overcome by "rewrit[ing] them in proper independent format and pay the appropriate fees." This suggestion itself demonstrates the fallacy of the objection and evidences that the objection is one of form only and not of any substance.

Specifically, the Board of Patent Appeals and Interferences explained in Ex parte

Porter that each dependent claim of a patent application "could be construed as an independent claim, drafted in a short-hand format to avoid rewriting the particulars of the [method] recited in the independent claims." 25 USPQ2d at 1147. Since this is so, there is absolutely nothing to be accomplished or corrected by simply going through the exercise of re-formatting claims 127, 128, 139, 146 and 147 into independent form. Yet, according to the Examiner, doing this would obviate the objection.

CONCLUSION

In view of the foregoing, claims 127, 128, 139 , 146 and 147 clearly are not in violation of either Rule 75(c) or the fourth paragraph of 35 U.S.C. § 112; this ground of objection should be vacated and the Examiner instructed to issue a Notice of Allowance.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,

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APPENDIX OF CLAIMS OBJECTED TO UNDER 37 CFR § 1.75(c)

127. A computer system for automatically determining a single simultaneous exchange of a plurality of commodities among a plurality of participants comprising:

one or more processors,

one or more links communicatively connecting the processors, and

one or more memories accessible by the processors and storing program instructions for causing the processors to perform the method of claim 116.

128. A computer readable medium having stored therein encoded computer-executable instructions for causing a computer to perform the method of claim 116 when said computer-executable instructions are loaded into said computer.

139. A computer readable medium having stored therein encoded computer-executable instructions for causing a computer to perform the method of claim 129 when said computer-executable instructions are loaded into said computer.

146. A computer for automatically representing a participant in an intermediated exchange of a plurality of commodities comprising:

a processor, and

a memory accessible by the processor and storing program instructions for causing the processor to perform the method of claim 140.

147. A computer readable medium having stored therein encoded computer-executable instructions for causing a computer to perform the method of claim 140 when said computer-executable instructions are loaded into said computer.